

REMARKS / DISCUSSION OF ISSUES

Claims 1-22 are pending in the present application. Claims 1, 3, 11, 14 and 20 are the independent claims.

Double Patenting Rejection

Applicants acknowledge the provisional double-patenting rejection under the judicially created doctrine of obviousness double-patenting. If necessary and proper, Applicants will provide a terminal disclaimer at a future date if such a rejection remains the only obstacle to allowance of the claims rejected hereunder.

Rejections under 35 U.S.C. § 101

The Office Action rejects claims 1-2 and 20-22 as being directed to non-statutory subject matter. For at least the reasons set forth below, Applicants submit that this rejection is improper and should be withdrawn.

Applicants direct attention to the USPTO Official Gazette Notice dated 22 November 2005, entitled “*Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*” (“the OG Notice”) merely contains guidelines for patent examiners, and like the MPEP 2106, does not have the full force and effect of law (see the OG Notice, Section I, second paragraph). This notwithstanding, the undersigned attorney has thoroughly reviewed these guidelines and respectfully submits that the rejections of claims 1-2 and 20-22 are not compliant with those guidelines.

At the outset, Section IV of the OG Notice explains in detail the procedures to be followed to determine whether a claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. § 101. Because the present rejection seems to call into question whether there is a ‘tangible result’ or a ‘physical transformation,’ Applicants direct attention to the section of the MPEP and the Guidelines entitled: “*Determine Whether the Claimed Invention Falls Within Sec. 101 Judicial Exceptions – Laws of Nature, Natural Phenomena and Abstract Ideas.*” Not surprisingly, the first thing the Examiner must do under Step IV(C) is to “*determine whether [a claim] covers*

either a Sec. 101 judicial exception or a practical application of a Sec. 101 judicial exception." Only if such a determination is made, does the analysis then proceed to determine if the claimed subject matter is nevertheless still patentable subject matter, for example, because: (1) the claim provides a physical transformation (Step IV(C)(1)(a)); or (2) the claims produces a useful, concrete, and tangible result (Step IV(C)(1)(b)).

Here, the Office Action does not ever attempt to determine whether any or all of claims 1-2 and 20-22 cover either a Sec. 101 judicial exception (Law of Nature, Natural Phenomenon, or Abstract Idea) or a practical application of a Sec. 101 judicial exception. Rather, the claims are dismissed as non-statutory as a matter of law (claims 1-2) and not physical 'things' (claims 20-22) with no analysis or explanation supporting this position. Indeed, Applicant respectfully submits that none of the claims 1-2 or 20-22 cover any law of nature, natural phenomenon, or abstract idea.

Accordingly, and for at least the reasons set forth above, Applicants respectfully submit that the rejections of claims 1,2 and 20-22 are improper and should be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1-22 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Zintel, et al.* US Patent Application Publication 2002/0029256. For at least the reasons set forth below, Applicants respectfully submit that this rejection is improper and should be withdrawn.

At the outset Applicants note that it seems that the incorrect paragraph of 35 U.S.C. § 102 is applied.

Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed.

Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Claim 1 states, *inter alia*:

“...at least one further level of subsidiary device types depending from the basic device type and inheriting properties of higher level device types on which the subsidiary device type depends, but not including any further level of subsidiary device types depending from the controller device type.”

Each of claims 3, 11, 14 and 20, while directed to different subject matter, include similar features.

In rejecting the noted features of claims 1, 3, 11, 14 and 20 the Office Action directs Applicants to paragraph [002] of the applied art. Nowhere in this portion of the applied art is there any disclosure of the *further level of subsidiary device types depending from the basic device type and inheriting properties of higher level device types on which the subsidiary device type depends, but not including any further level of subsidiary device types depending from the controller device type*. The mere disclosure of the automatic self-configuration for interoperability with peer networking devices as disclosed in the Technical Field of the applied art does not constitute that which is claimed. In addition to reviewing the relied-upon portion of the reference, Applicants have reviewed other portions as well to no avail. However, given the complexity of the subject matter and the voluminous nature of *Zintel, et al.* (95 pages and 48 sheets of drawings), Applicants respectfully submit that either the applied art fails to disclose that which is claimed, or the rejection fails to provide a clearly articulated rejection that complies with MPEP § 706, which states, in part:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity (emphasis added).

The rejection likewise fails to comply with 37 CFR § 1.104(c) (2), which provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified (emphasis added).

Respectfully, Applicants submit that because the portion of the applied art to which they have been directed for the alleged teachings of the noted portions of claims 1, 3, 11, 14 and 20 does not disclose that which is claimed, a *prima facie* case of anticipation has not been established. Moreover, and in view of the volume of material presented in *Zintel, et al.* and its complex nature, a clearly articulated rejection with an explanation of the relevance of the portions relied upon should have been provided. Otherwise, Applicants are left to in the precarious position of having to attempt to determine that which the Examiner regards as being disclosed in the reference. As such, and to the extent that *Zintel, et al.* applies, if *Zintel, et al.* is relied upon in future correspondence, any rejection cannot be made properly final.

For at least the reasons set forth above, because a *prima facie* case of anticipation has not been established, Applicants respectfully submit that claims 1, 3, 11, 14 and 20 are patentable over the applied art. Moreover, claims 2, 4-10, 12, 13, 15-19 and 21-22, which depend variously from the independent claims, are patentable for at least the same reasons and in view of their additionally recited subject matter.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
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